

### **REMARKS**

Claims 23-30 are now pending in the application. Claims 23-24, and 28-30 have been amended. Minor amendments have been made to the claims to simply overcome the rejections of the claims under 35 U.S.C. § 112. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

### **SPECIFICATION**

The specification stands objected to for certain informalities. Applicant directs the Examiner's attention to page 4 [0008], page 6 [0016], page 7 [0017], and claim 3 of the original application filed on June 21, 2001, where the bases of the percentages are clearly stated. Therefore, reconsideration and withdrawal of this objection are respectfully requested.

### **CLAIM OBJECTIONS**

Claims 29 and 30 have been objected to because of some informalities. Claims 29 and 30 have been amended according to the Examiner's suggestions. Therefore, reconsideration and withdrawal of this objection are respectfully requested.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 23-30 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Examiner states that the original specification does not teach the limitation “the ink image being visible ... vehicle.” Applicant directs the Examiner’s attention to paragraph [0005] which states that “[w]e have invented a new process by which printing of informational and other indicia may be placed, in accordance with industry and government standards, onto chrome and chrome plated products.” Reading the paragraphs [0005] and [0003] together, Applicant respectfully submits that the original specification does teach the limitation “the ink image being visible ... vehicle” in the disclosure of the invention. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

Claims 23, 24 and 28 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

Regarding the rejection of Claim 23, the Examiner’s attention is directed to Claim 23 which has been amended to clarify that the ink image is visible on a motor vehicle surface. Similarly, Claim 23 contains the limitation that “the ink image being visible on a motor vehicle surface when the automobile interior component is mounted in the motor vehicle,” while it does not require the ink images must ONLY be visible when “mounted in the motor vehicle,” as noted by the Examiner. Accordingly, the claim language in the “pressing” step of Claim 23 is sufficiently clear to define the invention.

Furthermore, Applicant respectfully directs the Examiner’s attention to paragraph [0008] which states that “[a] preferred method of curing an item printed in accordance with the teachings of the present invention, includes placing the item on a conveyor and feeding the conveyor through an annealing device which includes subjecting the printed

item to a temperature between 250.degree. and 260.degree. Fahrenheit for between 2 and 3 minutes. In a preferred embodiment, the printed item is cured in a dryer, or other device, at a temperature of 258.degree. Fahrenheit for 2.5 minutes. It is to be understood that variations of time and temperature in curing the printed items may be made without departing from the novel scope of the present invention.” Accordingly, the intended meanings of “predetermined” in the “heating” step of Claim 23 are sufficiently clear and defined in context to those skilled in the art.

Therefore, reconsideration and withdrawal of this rejection of Claim 23 are respectfully requested.

Regarding the rejection of Claim 24, Applicant directs the Examiner’s attention to page 4 [0008], page 6 [0016], page 7 [0017], and claim 3 of the original application filed on June 21, 2001, where the bases of the percentages in Claim 24 are clearly stated. Furthermore, Applicant directs the Examiner’s attention to Claim 24 which has been amended to include the limitation that “the ink comprises 60% of an epoxy ink and 40% of a hardening agent,” which makes the composition equal to 100%. Support for this limitation can be found in paragraph [0008]. Accordingly, Claim 24 as amended has overcome the above rejection. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

Applicant directs the Examiner’s attention to Claim 28 which has been amended to include the limitation of a key-shaped icon “showing a location of a keyhole.” Claim 28 as amended makes it clear how a “key-shaped icon” provides information “with respect to safe use of the motor vehicle.” Support for this limitation can be found in at least paragraph [0003]. Accordingly, Claim 28 as amended has overcome the above

rejections. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

**REJECTION UNDER 35 U.S.C. § 103**

Claims 23, 25, 29 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pryor et al. (U.S. Pat. No. 4,269,874) in view of Alden (U.S. Pat. No. 4,538,560) alone or in combination with the Admitted Prior Art (APA) of [0003]. Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pryor et al. (U.S. Pat. No. 4,269,874) in view of Alden (U.S. Pat. No. 4,538,560 and further in view of Reinke et al (U.S. Pat. No. 3,170,393.) Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Pryor et al. (U.S. Pat. No. 4,269,874) in view of Alden (U.S. Pat. No. 4,538,560) and further in view of APA. These rejections are respectfully traversed.

Claim 23 has been amended according to the Examiner's suggestion to include the limitation that "the formed ink image is long lasting," which addresses the "drawbacks" in the prior art and "might imply patentability," as suggested by the Examiner at lines 2-4 on Page 8 of the Office Action mailed on January 28, 2008.

Furthermore, Claim 23 as amended does not have limitation of "the specific logo, indicia, decoration, etc being stamped," as suggested by the Examiner. Moreover, the ink image in amended Claim 23 provides information to the user with respect to safe use of the motor vehicle, and does not relate to the choice of ornamentation as suggested by the Examiner. Applicant respectfully submits that as there are no matters

in amended Claim 23 related to the choice of ornamentation, *In re Seid* 73 USPQ 431 as cited by the Examiner does not apply.

Finally, regarding Claim 23, Applicant respectfully submits that the Office has not presented a prima facie case of obviousness. In this regard, the Office has not determined the scope and content of the prior art, ascertained the differences between the prior art and the claims, or considered the level of ordinary skill in the pertinent art. Rather, the Office has merely stated that Pryor et al. discloses routinely marking automotive parts via ink stamping while it does not teach “[a]pplying the raised inked portions to a part plated with chrome,” and that Alden teaches “chrome plated engine valve covers” and “the part comprising metal and plastic,” “hence it would have been obvious to the skilled artisan to have applied any such markings via ink stamping to signify quality, part type, or any other indicia, logo, etc for a specific automotive part.”

“Care must be taken to avoid hindsight reconstruction by using the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. *Grain Processing Corp. v. American Maize-Prods. Co.*, 5 U.S.P.Q.2d 1788, 1792 (inner quotes omitted); *see also*, *KSR*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385, 1397. The Examiner should not “pick and choose among the individual elements of assorted prior art references to recreate the claimed invention.” *Symbol Technologies Inc. v. Opticon Inc.*, 19 U.S.P.Q.2d 1241, 1246 (Fed. Cir. 1991); *see also*, *In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

Applicant notes that it is wholly improper to simply combine elements of Pryor et al. and Alden in this manner, even if all of the elements of the present claims could be found in either Pryor et al. or Alden. In this regard, Applicant notes that the Supreme

Court has stated that “[a]s is clear from cases such as *Adams*, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385, 1396 (2007). Moreover, in discussing the review of a determination of obviousness, the Supreme Court quoted from *In re Kahn* stating that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*

Applicant notes that in the wake of the KSR decision, the Board of Patent Appeals and Interferences (BPAI) appears to be enforcing the mandate for the “articulated reasoning” and “rational underpinning” to support the legal conclusion of obviousness. For example, the BPAI harshly rejected an examiner’s arguments concerning the obviousness of an invention in *Ex parte Fathman* (which they characterized as being a “willy-nilly” modification) and stated that

the inferences and creative steps derived from the prior art on this record fail to lead a person of ordinary skill in the art to Appellant’s claimed invention. On this record, the Examiner has failed to identify a viable reason why a person of ordinary skill would have been led to combine the teachings of [the cited art] in the manner set forth in Appellant’s claimed invention.

BPAI Appeal No. 2007-4156 (December 11, 2007). See also *Ex parte So and Thomas*, BPAI 2007-3967 (January 4, 2008) (BPAI cautioned against the unwitting application of hindsight and stated that “there is nothing in the applied references which would have motivated an artisan to select this particular ingredient then use the resulting composition...”).

Regarding Claim 23, Applicant respectfully submits that the Office has not presented a prima facie case of obviousness. For example, Applicant submits that the Office has provided only conclusory statements as a basis for the combination and has not provided “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” In this regard, the Office has not stated why one of ordinary skill in the art, having knowledge of both Pryor et al. and Alden, would routinely mark the “chrome plated engine valve covers” of Alden via ink stamping, as taught by Pryor et al., especially when it is well known that pad printing on chrome plated parts has been found to be not long lasting and may easily be removed from the part in the normal course of usage of the printed object. See paragraph [0004]. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 23, under 35 U.S.C. §103(a).

Claims 25-30 depend from Claim 23, and they all stand rejected under 35 U.S.C. § 103(a) by at least combining elements of Pryor et al. and Alden in the same manner, therefore reconsideration and withdrawal of the rejection of Claims 25-30 are respectfully requested for at last the reasons stated above with reference to Claim 23.

## **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: April 28, 2008

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